

Application No. 09/604,083
Attorney Docket No. 045112-0077

selected on a basis of toxicity against mold mites.

2. The pesticidal composition of claim 1, wherein the compound is phenyl ethyl alcohol.

8. The pesticidal composition of claim 1, wherein the compound is phenyl ethyl propionate.

REMARKS

Claims 1, 2 and 8 are pending. Claims 1, 2 and 8 are amended to encompass infringing subject matter. Applicant respectfully retains the right to file continuing applications. Attached hereto is a marked-up version of the changes made to the claims by the above amendments. The attached page is captioned "Version With Markings To Show Changes Made." No new matter has been added.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 2 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as his invention. In particular, the Office Action states that there is a lack of antecedent basis for the phrase "pesticidal composition." Solely in an effort to advance prosecution, claim 1 has been amended to re-insert "pesticidal" before the term "composition", thereby providing antecedent basis. The rejection is overcome.

REJECTIONS UNDER 35 U.S.C. § 102

The Office Action rejects claims 1 and 2 under 35 U.S.C. § 102(b) as allegedly being anticipated by Morita (JP 04059703) and Friedman (U.S. Patent No. 4,446,161). The Office Action states:

JP 04059703 teaches a miticidal composition comprising
carvone, p-methyl acetophenone, 2-phenylethyl alcohol,
(iso)thymol, methyl benzoate and/or methyl salicylate in the form

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of emulsions, dispersions, oil preparations, dusts, tablets or propellants.

It is noted that the reference does not expressly teach that composition can be used in the manner instantly claimed (i.e., for the control of mold mites), however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

Friedman teaches food product compositions comprising effective dose amounts of aromatic alcohols for the control of microbial growth including bacteria, molds and yeasts, and the growth and reproduction of mite infestation, such as that caused by the mold mite, i.e., (*Tyrophagus putrescentiae*). See column 13, under "EXAMPLE 10". Friedman teaches that the level of aromatic alcohols comprising the composition is from about 0.15 to about 1.0%, or 0.15 to about 1.5%, or 0.75 to about 1.25%, or 0.1 to about 0.75%, or 0.75 to 1% based on the weight of the food and other physiologically parameters (see Column 6, lines 12-33). Aromatic alcohols, such as the claimed phenyl ethyl alcohol, can be used alone as the effective active agent in the compositions taught by Friedman. Friedman also teaches that phenyl ethyl alcohol can be combined with an acceptable carrier, such as a food product. For instance, in Column 9, under "EXAMPLE 2", Friedman teaches a food product composition comprising 2-phenylethanol or phenyl ethyl alcohol. See also "EXAMPLE 4", in Column 10. In Column 14, lines 41-55, Friedman teaches another food product comprising 2-phenylethyl alcohol.

Office Action at pages 3-4. Applicant respectfully traverses these rejections.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention. *The Kegel Co. v. AMF Bowling*, 127 F.3d 1420, 44 USPQ2d 1123 (Fed. Cir. 1997); *Gechter v. Davidson*, 116 F.3d

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1454, 43 USPQ2d 1030 (Fed. Cir. 1997). In rejecting a claim under 35 U.S.C. § 102, the Patent Office is required to identify wherein a particular reference identically discloses each feature of the claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). There are significant differences between the claimed invention and each of Morita and Friedman.

The pending claims are directed to pesticidal compositions comprising an acceptable carrier and a compound from the group consisting of phenyl ethyl alcohol and phenyl ethyl propionate. The claimed pesticidal composition further requires a pesticidally effective amount of a compound that has been *selected on a basis of toxicity against mold mites*. Contrary to the Office Action's assertion, the claimed invention is not an intended use of a known composition. Rather, the claimed invention stems from the discovery that certain compounds can be selected for their superior toxic effects against mold mites in comparison to other plant essential oil compounds (e.g., trans-anethole and benzyl alcohol).

Morita merely discloses a composition to **repel** mites comprising methyl acetophenone, 2-phenylethyl alcohol, iso-thymol, methyl benzoate and/or methyl salicylate. Applicant respectfully submits that the disclosed compounds in Morita are merely selected on a basis of repellency of mites.

Likewise, Friedman merely disclose a food preservation system that is effective to prevent mite growth. In Example 10 at column 13, lines 26-61, Friedman states:

Each of these [kib formulation] batches was subdivided into five portions and benzyl alcohol was added at five different levels—namely 0.5%, 0.75%, 1.00%, 1.25% and 1.50% and subjected to mite studies. According to themite [sic] test procedure, a two-gram sample of each product is placed into 20 small vials and each vial is inoculated with ten gravid mites (*Tyrophagus putrescentiae*) which have been established as viable. The vials are stored at 25°C. and 85% R.H. and at 3, 6, 12 and 16 week periods, five replicate samples are removed from storage and examined for live mites.

The samples are considered non-stable by the presence of an

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average of 30 live mites per vial. After 16 weeks, all of the samples of the experiment were found to be stable. [Emphasis added]

Applicant respectfully submits that Friedman teaches, in Example 10, an average number of mites per vial that is *less* than 30 (e.g., 29) would be considered "stable." As such, Friedman does not teach that the disclosed compounds (e.g., benzyl alcohol in Example 10) are toxic against mites, let alone that phenyl ethyl alcohol is *selected* for its toxicity against mites or present in the disclosed food preservation systems in pesticidally-effective/mitotoxic amounts to obtain the pesticidal composition of the claimed invention.

Applicant respectfully submits that in view of their deficiencies, Morita and Friedman, alone or improperly combined, do not disclose or suggest each and every feature of the claimed invention. Neither applied reference discloses or suggests Applicant's solution to the underlying technical problem of making available a product whose active ingredient is selected for its toxicity against mold mites, as required by the claimed invention. Morita and Friedman are conspicuously mute as to this fundamental concept. This fundamental difference alone between the claimed invention and each of Morita and Friedman is sufficient to undermine the factual determination of lack of novelty under 35 U.S.C. § 102. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

The Office Action rejects claims 1 and 8 under 35 U.S.C. § 102(b) as being anticipated by McGovern and JP 85049452. The Office Action states:

McGovern teaches a composition comprising phenyl ethyl propionate and eugenol (an acceptable carrier).

JP 85049452 teaches an insect catching apparatus comprising a bag of resin (an acceptable carrier) and 2-phenyl ethyl propionate.

It is noted that the references do not expressly teach that the composition can be used in the manner instantly claimed, however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is

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inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

Office Action at Page 5. Applicant respectfully traverses this rejection.

McGovern merely discloses an **attractant** for Japanese beetles consisting of phenyl ethyl propionate and eugenol. Likewise, JP 85049452 merely discloses an **attractant** for harmful insects containing 2-phenyl ethyl propionate, etc. Neither McGovern nor JP 85049452 discloses that phenyl ethyl propionate is toxic against mold mites, let alone, may be selected on the basis of its toxicity against mold mites, as required by the claims. As such, neither McGovern nor JP 85049452 anticipate the claimed invention. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Moreover, to whatever extent the imposed rejections under 35 U.S.C. § 102(b) are predicated upon the doctrine of inherency, such reliance would be totally misplaced. It is, of course, well settled that the doctrine of inherency of a feature recited in a claimed invention requires both certainty and recognition in the art. *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 167 (Fed. Cir. 1994); *Electro Medical Systems S.A. v. Cooper, Life Sciences, Inc.* 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). The requirement for certainty coupled with art recognition is not satisfied by either of the applied references. There is no basis upon which to predicate the determination that the mere teachings in Morita or Friedman involves teaching the selection of the compounds recited in the claimed invention and that such selection would have been recognized by one having ordinary skill in the art. *In re Paulsen*, supra; *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, supra. As such, reconsideration and withdrawal of the rejection over Morita and Friedman are respectfully requested.

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DOUBLE PATENTING

Claims 1, 2 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 10 and 16 of copending Application No. 09/604,157 (45112-0081). In response, Applicant respectfully acknowledges the need to cancel or amend claims if ultimately allowed claims in the above-captioned patent application improperly conflict with, or are coextensive in scope. Applicant respectfully requests that this rejection be held in abeyance until allowable subject matter is indicated.

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CONCLUSION

Early consideration and prompt allowance of the pending claims are respectfully requested. If anything could be done to place this application in condition for allowance, (e.g., **an Examiner's Amendment**) Applicant respectfully requests that the Examiner contact the undersigned representative at the telephone number listed below.

Please grant any extension of time necessary for entry of this communication.
Please charge any deficient fees, or credit any overpayment of fees, to Deposit Account No. 50-0417. A duplicate copy of this communication is attached.

Respectfully submitted,

Date: May 19, 2003

By:

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this document (including any paper referred to as being attached or enclosed) is being sent to the U.S. Patent and Trademark Office via facsimile transmission to (703) 872-9306 on the date indicated below, with a coversheet addressed to Commissioner for Patents, U.S. Patent and Trademark Office, Alexandria, Virginia 22213.

Date: May 19, 2003
By: Willem F. Gadiano
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ATTACHMENT

Version With Markings To Show Changes Made

IN THE CLAIMS

Claims 1, 2 and 8 are amended, as follow.

1. (Three Times Amended) A pesticidal composition [for the control of mold mites] comprising an acceptable carrier and at least one [plant essential oil] compound selected from the group consisting of phenyl ethyl alcohol and phenyl ethyl propionate, said pesticidal composition having a pesticidally effective amount of said [plant essential oil] compound selected on a basis of toxicity against mold mites.

2. (Three Times Amended) The pesticidal composition of claim 1, wherein the [plant essential oil] compound is phenyl ethyl alcohol.

8. (Twice Amended) The pesticidal composition of claim 1, wherein the [plant essential oil] compound is phenyl ethyl propionate.